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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/645,593

08/25/2000

Sarita Chaudhary

9369-151/MG

4599

1059

7590

01/11/2002

BERESKIN AND PARR
SCOTIA PLAZA
40 KING STREET WEST-SUITE 4000 BOX 401
TORONTO, ON M5H 3Y2
CANADA

EXAMINER

KRUSE, DAVID H

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 01/11/2002

/d

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/645,593

Applicant(s)

CHAUDHARY ET AL.

Examiner

David H Kruse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-23, drawn to a method of expression of a nucleic acid sequence comprising a seed-specific promoter obtained from flax wherein said flax seed-specific promoter comprises the nucleic acid sequence as shown in SEQ ID NO: 1, transgenic flax plants and seed prepared by said method, a nucleic acid having the sequence of SEQ ID NO: 1, a chimeric nucleic acid comprising said nucleic acid, a method for the expression of a nucleic acid sequence of interest in a plant seed comprising said chimeric nucleic acid and plants transformed therewith, classified in class 800, subclass 287, for example.
 - II. Claims 1-23, drawn to a method of expression of a nucleic acid sequence comprising a seed-specific promoter obtained from flax wherein said flax seed-specific promoter comprises the nucleic acid sequence as shown in SEQ ID NO: 4, transgenic flax plants and seed prepared by said method, a nucleic acid having the sequence of SEQ ID NO: 4, a chimeric nucleic acid comprising said nucleic acid, a method for the expression of a nucleic acid sequence of interest in a plant seed comprising said chimeric nucleic acid and plants transformed therewith, classified in class 800, subclass 287, for example.

- III. Claims 1-23, drawn to a method of expression of a nucleic acid sequence comprising a seed-specific promoter obtained from flax wherein said flax seed-specific promoter comprises the nucleic acid sequence as shown in SEQ ID NO: 6, transgenic flax plants and seed prepared by said method, a nucleic acid having the sequence of SEQ ID NO: 6, a chimeric nucleic acid comprising said nucleic acid, a method for the expression of a nucleic acid sequence of interest in a plant seed comprising said chimeric nucleic acid and plants transformed therewith, classified in class 800, subclass 287, for example.
- IV. Claims 1-23, drawn to a method of expression of a nucleic acid sequence comprising a seed-specific promoter obtained from flax wherein said flax seed-specific promoter comprises the nucleic acid sequence as shown in SEQ ID NO: 8, transgenic flax plants and seed prepared by said method, a nucleic acid having the sequence of SEQ ID NO: 8, a chimeric nucleic acid comprising said nucleic acid, a method for the expression of a nucleic acid sequence of interest in a plant seed comprising said chimeric nucleic acid and plants transformed therewith, classified in class 800, subclass 287, for example.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In

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the instant case the different inventions are unrelated because a nucleic acid having the sequence of SEQ ID NO: 1, 4, 6 or 8 is compositionally, structurally and functionally distinct one from the other. The claimed promoter sequences appear to be associated with distinct flax genes, and thus are patentably distinct.

3. **Applicant is required to elect** one nucleic acid sequence to be examined in conjunction with the elected group of claims. The Patent and Trademark Office recently published its policy for the examination of patent applications that claim large numbers of nucleotide sequences in the Official Gazette, 1192 O.G. 68 (November 19, 1996). Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. § 121. Absent evidence to the contrary, each such nucleotide is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. § 121 and 37 CFR § 1.141. In establishing the new policy, the Commissioner has partially waived the requirements of 37 CFR § 1.141 et seq. and permits a reasonable number of such nucleotide sequences to be claimed in a single application. It has been determined that normally ten sequences constitute a reasonable number for examination purposes. The Official Gazette Notice of November 19, 1996 is one that permits the examiner to waive restriction to no more than one invention. Since 1996, databases and resource allocations at the PTO have changed and the examination of 10 sequences on the merits in the instant application would present a burden on PTO resources. Additionally, it is noted that one nucleotide and one amino acid sequence is

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within the O.G. notice range of "up to ten" sequences. This election is not to be construed as an election of species.

4. Applicant is advised that the reply to this requirement to be complete within one month (not less than 30 days) must include an election of the invention to be examined even though the requirement be traversed (37 CFR § 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (703) 306-4539. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Amy Nelson can be reached at (703) 306-3218. The fax telephone number for this Group is (703) 872-9306 Before Final or (703) 872-9307 After Final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the William Phillips whose telephone number is (703) 305-3482.

David H. Kruse, Ph.D.
9 January 2002

DAVID T. FOX
PRIMARY EXAMINER
GROUP 100-1638

